

Copenheaver, Blaine

F. Young

From: JMassie@nixonpeabody.com
Sent: Sunday, December 15, 2002 5:52 PM
To: Blaine.copenhaever@uspto.gov
Cc: blaine.copenheaver@uspto.gov; DRESNICK@nixonpeabody.com
Subject: FW: Help!



BOSDOC_1-650487-v1-

51380 MEMO... Blaine, Please read this memo, from client, re DO/EO case, can I bring complete copy of what was filed to Cathy on Tuesday to try to straighten this out....the WIPO publication is what appears to have caused problem...Jerry

> -----Original Message-----

> From: Valtz, Nicole
> Sent: Friday, December 13, 2002 11:42 AM
> To: Massie, Jerry; Resnick, David; Valtz, Nicole
> Subject: Help!

>
> <<BOSDOC_1-650487-v1-51380 MEMO RE STATUS.DOC>>
>
> Hi Jerry-
>
> We are having a difficult time sorting out the status of a national
> phase entry we filed in the U.S. in August 2001, which is still hung
> up in docketing. I prepared the attached memo to describe the
> situation. We are hoping to invoke your special powers to help us out
> here. When you get a chance, we would be thrilled if you could look
> this over and give us your suggestions for how to proceed. Please
> just give me or David a call if this is unclear in any way.

>
> Thanks very much!!
>
> Nicole and David.
>
>
>
>
>

MEMO

TO: David Resnick; Jerry Massie; 51830 File

FROM: Nicole Valtz

DATE: December 13, 2002

RE: N. Lightowler et al.
U.S.S.N. 09/890,816
Based on PCT/GB00/00277
Murgitroyd Ref. No. P22866C/AHO/PPP
Our Ref. No. 740789-51830

This memo describes my efforts to determine the status of the above-identified case in the U.S. PTO.

PCT/GB00/00277 was filed February 1, 2000. Accordingly, pursuant to the client's request, we filed the entry into the U.S. National Phase under Chapter II in the E.O./U.S. (Elected Office/United States) on August 1, 2001.

On August 13, 2001, we received a date-stamped return receipt postcard from the EO/U.S., stamped "JC20 Rec'd PCT/PTO 01 Aug 2001" and also stamped "09/890,816."

The file was reviewed on February 6, 2002, but no Notice of Acceptance had been received.

Our docketing system triggered a further review of this file. My review of this file in October, 2002 indicated that nothing had been received from the EO/U.S. since the initial filing postcard. Accordingly, on October 28, 2002 I made a series of telephone calls to Tech Center 1600, the Office of Initial Patent Examination (OIPE, 703-308-1202), and the PCT help desk (703-305-3257). These calls determined that the PTO system indicates that the filing fees had been processed at the time they were received, a request for notice from docketing was filed August 22, 2001, and that the file had been in the contractor's office since May 26, 2002. Although OIPE told me that I could not call the contractor's office directly, the PCT help desk said that the case was sidetracked when it was supposed to be docketed in the EO/U.S., and that I should call Donna Greene at 703-305-3619.

Accordingly, I called Donna Greene on October 28, 2002 and October 29, 2002. She left me a message several days later indicating that I should speak with the docketing clerk assigned to the file, Francine Young, at 703-305-3662.

After several attempts, I spoke with Ms. Young in mid-November. She indicated that this case was a "big problem" because the specification we provided was different from the published PCT application, that she could not locate the claims in our specification, and that she had looked at the WIPO publication which did not match our filing. I indicated that I would investigate the matter and call her back, which I did that morning.

I printed the 212 page WIPO publication (WO 00/45333) and the papers that we filed with the national phase entry (212 pages). The two sets of papers are identical. The confusion appears to reflect the structure of this specification, which has the following parts, in this order:

2 pages of publication coversheet;
Pages 1 – 79: specification;
Pages 80 – 84: claims;
(unnumbered): 16 sheets of drawings (32 total Figures);
Pages 1 – 104: specification;
Pages 105 – 107: Appendix A; and
International Search Report (3 pages).

Thus, the only claims in this application are found in the middle of the publication, at the first set of pages numbered 80 – 84.

I called Ms. Young back within an hour and attempted to explain that the papers were identical. However, Ms. Young maintained that the WIPO publication was comprised (only) of 84 sheets of text, 16 drawings, and 23 claims, whereas we had filed only 107 sheets of text, 16 sheets of drawings, 3 sheets of appendix, and no claims whatsoever. Despite my attempts to argue that we had filed the entire application, which included all of the above pages, she did not accept my argument. Accordingly, I indicated that I would pursue this with her supervisor, Ms. Greene.

My attempts to reach Ms. Greene since mid-November have been numerous and unsuccessful, despite my leaving repeated messages asking her to call me. On December 11th, her voicemail indicated that she would be out of the office until next week, and any urgent matter should be directed to Katherine Short at 703-305-3620. On Dec. 11th I left Ms. Short a message asking her to call me, which was not returned. On Dec. 12th her voicemail indicated that it was completely full, and therefore I could not leave a further message.